

REMARKS

In response to the Office Action dated 12 March 2004, the applicant requests reconsideration of the above-identified application in view of the following remarks. Claims 1-30 are pending in the application, and claims 3, 4, 7-15, 19, and 22-30 are withdrawn. Claims 1, 2, 5, 6, 16-18, 20, and 21 are rejected. Claim 18 will be canceled, claims 1, 5, 6, 16, 20, and 21 will be amended, and new claims 31-37 will be added, upon entry of the present amendment. No new matter has been added.

New Claims

New claims 31-37 are dependent on pending claims, and recite further features with respect to those claims.

Information Disclosure Statement

The applicant filed an Information Disclosure Statement on 29 May 2002 including two (2) sheets of Form 1449. The applicant respectfully requests entry of that Information Disclosure Statement and requests that the documents listed on the attached Forms 1449 be considered by the Examiner and made of record. Pursuant to the provisions of MPEP 609, the applicant requests that copies of the 1449 forms, initialed as being considered by the Examiner, be returned to the applicant with the next official communication.

Rejection of Claims Under §102

Claims 1, 2, 16 and 17 were rejected under 35 USC § 102(b) as being anticipated by Shiono et al. (US 5,519,803, Shiono). The applicant respectfully traverses.

Independent claims 1 and 16 will be amended upon entry of the present amendment to include features similar to those found in original claim 18. Original claim 18 was rejected under 35 USC § 103(a), and amended claims 1 and 16 will be discussed below with respect to that rejection.

The applicant respectfully submits that amended claims 1 and 16 are in condition for allowance for the reasons stated below. Claims 2 and 17 are variously dependent on claims 1 and 16, and recite further features with respect to claims 1 and 16. For reasons analogous to those stated below, and the features in the claims, the applicant respectfully submits that claims 2 and 17 are in condition for allowance.

Rejection of Claims Under §103

Claims 5, 6, 18 and 20 were rejected under 35 USC § 103(a) as being unpatentable over Shiono. The applicant respectfully traverses.

Claim 21 was rejected, but was not addressed in the Office Action. The applicant respectfully submits that claim 21 is in condition for allowance.

Original claim 18 will be canceled upon entry of the present amendment, and features similar to those found in original claim 18 will be added to independent claims 1 and 16 upon entry of the present amendment. Amended claim 1 recites an integrated photonic apparatus comprising, among other elements, a glass overladding including a first region wherein the first region is positioned to substantially confine a pump light. Amended claim 16 recites a method comprising, among other elements, forming a plurality of regions on the glass substrate including a first region, wherein the first region acts to substantially confine a pump light. Claim 6 will be amended upon entry of the present amendment to be in independent form, and recites an integrated photonic apparatus comprising, among other elements, “a pump light is introduced into the first region.”

Shiono relates to an optical waveguide,¹ but does not show a pump light. The Office Action asserts that:

“utilizing a structure such as the one disclosed by Shiono to support a pump light is well known. It would have been obvious....to utilize the first region for a pump light in order to improve versatility of the device as a gain medium in optical communication devices.”²

The Office Action has not provided a reference showing such. The MPEP requires that the applied reference (or references) teach or suggest all the claim limitations for a rejection under 35 USC § 103:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

¹ Shiono, title.

² Office Action, page 3.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”³

The suggestion must be found in the prior art.⁴

The Office Action has not identified prior art showing a pump light, or suggesting that a pump light be applied to Shiono as stated in the Office Action, as is required by MPEP 2143.

The applicant respectfully submits that a *prima facie* case of obviousness has not been established against amended claims 1, 6, and 16, and that claims 1, 6, and 16 are in condition for allowance.

Claims 2, 5, 17, and 20 are variously dependent on amended claims 1 and 16, and recite further features with respect to claims 1 and 16. The applicant respectfully submits that a *prima facie* case of obviousness has not been established against claims 2, 5, 17, and 20, and that claims 2, 5, 17, and 20 are in condition for allowance.

³ MPEP 2143.

⁴ MPEP 2143.

CONCLUSION

The applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at 612-373-6973 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By his Representatives,

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Date

12 August 2004

By

Robert E. Mates
Reg. No. 35,271



CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 12 day of August, 2004.

CANDIS BUENDING

Name

Signature

